

Yasuharu Suda et al.
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inter alia, in the specification at page 14, line 18 through page 15, line 4.

Applicants maintain that no new matter is presented by this amendment. Accordingly, Applicants respectfully request that this Amendment be entered.

Rejection under 35 U.S.C. §112, first paragraph

On page 2 of the September 27, 2002 Office Action, claims 21-28 were rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which allegedly was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

The Examiner stated that the instant claims have been amended to specify that during manufacture of the liquid toner heating is performed to dissolve a thermoplastic resin, as specified, "while stirring the thermoplastic resin in said solvent together with inorganic particles and a coloring agent subjected to dispersion and mixing ...". The Examiner further stated that although the specification discloses stirring of the dissolved thermoplastic resin and inorganic particles in the solvent, the specification does not disclose stirring this combination with colorant particles that have been subjected to dispersion and mixing. The Examiner also stated that the only possible basis for this disclosure appears to be Example 1 and in this example a dispersion of inorganic fine particle (not identified as a colorant) is combined with a specific resin and a specific phthalocyanine pigment. The Examiner further stated that the specific pigment was subjected to dispersion treatment within a mixed solvent using the dispersing apparatus.

The Examiner stated that the claims are not limited to the only description corresponding to the noted limitations. The Examiner

further stated that there is no broader disclosure in the specification to show that any colorant (e.g., a dye or other pigment) is processed in the same manner as the specification Example 1. The Examiner also stated that the specification is clear that the phthalocyanine pigment is subjected to a "dispersion treatment" within a mixed solvent. The Examiner further stated that it is not clear what the dispersion treatment is and the mixed solvent is not disclosed. The Examiner stated that if these limitations were added to the claims the claims would appear to be non-enabling because there is no guidance as to the dispersion treatment or the composition or characteristics of the mixed solvent. The Examiner further stated that the claims include the situation where the colorant was not subject to a treatment during dispersion and not conducted within a mixed solvent (e.g., a single solvent). The Examiner also stated that the specification does not disclose these other alternatives included within the scope of the claims.

The Examiner stated that the specification as filed does not provide basis for the claims because the specification example describes certain characteristics and components as noted above. The Examiner further stated that the claims do not include these characteristics and components and contain new matter.

In response, without conceding the correctness of the Examiner's position but solely to advance the prosecution of the subject application, Applicants have hereinabove amended claim 21. Applicants maintain that the claim amendments do not narrow the scope of the claimed invention, but rather place the claims in better form for examination.

Applicants maintain that the claimed invention as set forth in amended claim 21 is fully supported by the specification.

Accordingly, Applicants respectfully request that the Examiner

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reconsider and withdraw the rejection of claims 21-28 under 35 U.S.C. §112, first paragraph.

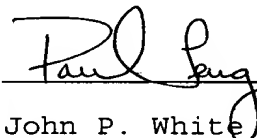
In view of the amendments to the claims and remarks hereinabove, Applicants maintain that claims 21-28 are now in condition for allowance. Accordingly, Applicants earnestly solicit the allowance of claims 21-28.

If a telephone interview would be of assistance in advancing prosecution of the subject application, Applicants' undersigned attorneys invite the Examiner to telephone them at the telephone number provided below.

If a petition for an extension of time is required to make this response timely, this paper should be considered to be such a petition, and the Commissioner is authorized to charge the requisite fees to our Deposit Account No. 03-3125.

No fee is deemed necessary in connection with the filing of this Amendment. However, if any additional fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,



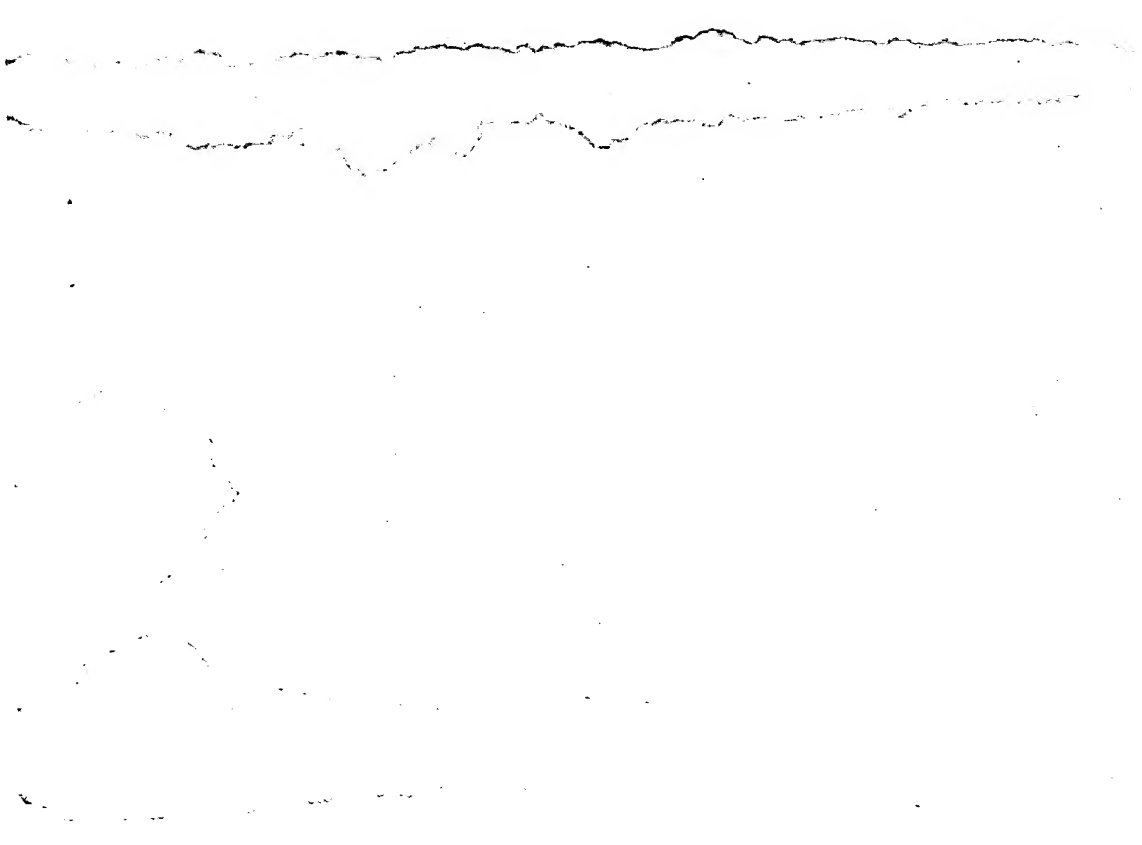
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I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.



Paul Teng
Reg. No. 40,837

December 19, 2002
Date



21. (Four Times Amended) A method of manufacturing a liquid toner composition for electrophotography, comprising:

heating a thermoplastic resin within a solvent capable of dissolving said thermoplastic resin when heated and substantially incapable of dissolving said resin at room temperature, an SP (solubility parameter) value of said solvent being adjusted to control the particle diameter of toner particles on a basis of a difference between an SP value of the resin and the SP value of the solvent, while stirring the thermoplastic resin in said solvent together with inorganic particles [and a coloring agent subjected to dispersion and mixing], to thereby dissolve said thermoplastic resin in said solvent; and

cooling the mixture to permit precipitation of the toner particles.
